

DISPUTE RESOLUTION SERVICE

D00012696

Decision of Independent Expert

L'Oréal SA

and

Timothy Schmidt

1. The Parties:

Complainant: L'Oréal SA
Rue Royale 14,
Paris
75008
France

Respondent: Timothy Schmidt
200 Stonewall Blvd
Wrentham
Maine
02093
United States

2. The Domain Name(s):

clarisonicbrush.co.uk (“the Domain Name”)

3. Procedural History:

Expert's declaration

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a

nature as to call in to question my independence in the eyes of one or both of the parties.

Dispute Chronology

10 April 2013 09:34 Dispute received
10 April 2013 10:36 Complaint validated
10 April 2013 10:38 Notification of complaint sent to parties
29 April 2013 02:30 Response reminder sent
02 May 2013 08:14 No Response Received
02 May 2013 08:14 Notification of no response sent to parties
09 May 2013 11:02 Expert decision payment received

4. Factual Background

The Complainant is one of the world's largest suppliers of cosmetics and beauty products. Since 2001, Pacific Bioscience Laboratories Inc., a US subsidiary of the Complainant, has distributed a range of "sonic skin cleansing" devices under the name "Clarisonic". In 2012, worldwide sales of Clarisonic products were approximately \$200 million.

The Complainant owns various trade mark registrations for the word "CLARISONIC" including Community Trade Mark No. 005732375 dated 5 March 2007 in classes 3, 5, 21, 35 and 44.

The Respondent registered the Domain Name on 5 December 2012.

Thereafter the Respondent used the Domain Name for a website which was branded with the Complainant's trade mark and logo and which mimicked the look and feel of the Complainant's own website. The website offered goods for sale which were either the Complainant's own products or counterfeit versions thereof.

When I checked the website on 30 May 2013, it consisted simply of a blank page but for the word "Error!".

5. Parties' Contentions

Complaint

The Complainant contends as follows:

The Domain Name is confusingly similar to trade marks in which Complainant has rights. The fact that the Domain Name differs from the Complainant's trade marks by the addition of the non-distinctive element "brush" does not affect confusing similarity. The distinctive component of the Domain Name is the mark, which is a famous brand name. Indeed, the term "brush" is particularly apt to induce Internet

users to believe that there is an association between the Domain Name and the Complainant since it is clearly descriptive of the Complainant's products.

The Respondent is not a licensee, an authorised agent of the Complainant or in any other way authorised to use the Complainant's trade mark.

The Domain Name is being used for a commercial website which creates a likelihood of confusion with the Complainant's official website including reproduction of the look and feel of that website and the prominent offering for sale of unauthorised products bearing the Complainant's trade mark.

Such wilful conduct clearly demonstrates that the Respondent does not intend to use the Domain Name in connection with any legitimate purpose.

The Respondent was undoubtedly aware of the existence of the Complainant's trade mark registrations when he registered the Domain Name for the purpose of capitalising on the reputation of the Complainant's marks by the diversion of Internet users seeking information about the Complainant.

The actual knowledge of the Complainant's trade mark is also clearly demonstrated by the fact that the Respondent's website has copied the look and feel and layout of the Complainant's website including prominent display of the Complainant's trade mark and the offering for sale of products bearing the trade mark.

The Domain Name, consisting of a combination of the Complainant's trade mark and a descriptive term related to the Complainant's products is bound to lead to initial interest confusion.

The use of the Domain Name to sell goods which are likely to be counterfeit is a further indication that the Domain Name is an abusive registration.

The Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (paragraph 3(a)(ii) of the Policy) and primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 3(a)(i)(Complainant) of the Policy).

The Respondent has also engaged in a pattern of abusive registrations pursuant to paragraph 3(a)(iii) of the Policy. The Respondent is the registrant of at least four additional domain names bearing similar whois information to that shown for the Domain Name: 1moncler.com, monclerjassenus.com, moncleralfred.com, uggoutletschweiz.ch.

The postal address indicated in the whois for the Domain Name is false. There is no town named Wrentham in Maine whereas there is such a town in Massachusetts. Pursuant to paragraph 3(a)(iv) of the Policy, the Respondent has supplied false contact details.

Response

The Respondent did not file a Response.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Complainant's rights

The meaning of "rights" is clarified and defined in the Policy in the following terms:

"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning"

The Complainant has established rights in the mark "CLARISONIC" by virtue of its registered trade marks for that term.

The Complainant argued in terms of "confusing similarity" between the trade mark and Domain Name but, under the Policy, it is only necessary to establish "similarity". The mark is undoubtedly similar to the Domain Name, which consists of the Complainant's distinctive trade mark plus a descriptive term, which is directly referable to the Complainant's business.

I conclude therefore that the Complainant has established rights in a name or mark which is similar to the Domain Name (disregarding the domain name suffix).

Abusive registration

Is the Domain Name an abusive registration in the hands of the Respondent?

Paragraph 1 of the DRS Policy defines "abusive registration" as a domain name which either:-

- "i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR*
- ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

In my view, this is a clear case of abusive registration and it is unnecessary to have regard to the non-exhaustive examples of the abusive registration set out in the Policy.

The Respondent has set out to impersonate the Complainant. The Complainant has provided evidence of the Respondent's use of a website at the Domain Name which was very similar to the Complainant's own website including use of the Complainant's own logo as well as reproduction of the look and feel, layout and colour scheme of the Complainant's site. Also, there was a copyright notice "© 2012 Pacific Clarisonic Mia Inc.", which appears to be a combination of the name of the Complainant's subsidiary "Pacific Bioscience Laboratories Inc." as well as the name of the Complainant's consumer brand: "Clarisonic Mia".

The Respondent's website offered for sale products branded with the Complainant's own mark. The Complainant says that the low prices indicate that the products were "likely" to be counterfeit but produces no other evidence in support of that assertion. However, in my view it makes no difference whether or not the products were counterfeit. Even if the Respondent was simply re-selling genuine Clarisonic products, it was abusive to do so in a manner whereby the Respondent deliberately set out to impersonate the Complainant. If the products were counterfeit, then the Respondent's behaviour was even more egregious.

For the reasons stated above I find that the Domain Name is an abusive registration in that it has been registered and/or used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights.

7. Decision

I find that the Complainant has rights in a mark which is similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name be transferred to the Complainant.

Signed: Adam Taylor

Dated: 30 May 2013